

REMARKS

Applicant has reviewed the Office Action dated August 18, 2003, and the references cited therewith.

No claims are amended, canceled or added; as a result, claims 16-46 are now pending in this application.

Objection to the Specification

In the Office Action, the specification was objected to as failing to provide proper antecedent basis for the claimed subject matter.

Applicant respectfully traverses the objection to the specification. Pursuant to MPEP § 608, "Applicant may rely for disclosure upon the specification with original claims and drawings, as filed." Applicant respectfully submits Figures 1 and 9-14, as filed, show coradial conductors (142, 144, 146, 148, 240, 242, 244, and 246) wound about a single axis at substantially similar radii with respect to the single axis. Furthermore, Applicant respectfully submits the specification is sufficient to enable a person skilled in the pertinent art or science to make and use the invention without undue experimentation. See M.P.E.P. § 608.01(g).

Withdrawal of the objection to the specification is respectfully requested.

112 Rejections of the Claims

In the Office Action, claims 16 – 26 and 43 - 46 were rejected under 35 USC 112, first paragraph, as failing to comply with the written description requirement. Additionally, claims 16 – 26 and 43 - 46 were rejected under 35 USC § 112, first paragraph, as failing to comply with the enablement requirement. Further, claims 16 – 26 and 43 – 46 were rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Pursuant to MPEP § 608, "Applicant may rely for disclosure upon the specification with original claims and drawings, as filed." Applicant respectfully submits Figures 1 and 9-14, as filed, show conductors (142, 144, 146, 148, 240, 242, 244, and 246) wound about a single axis at substantially similar radii with respect to the single axis. Applicant respectfully submits the disclosure, as filed, reasonably conveys to one skilled in the relevant art that the inventors, at the

time the application was filed, had possession of the claimed invention. Additionally, Applicant respectfully submits the disclosure including the drawings, as filed, enables one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Moreover, Applicant respectfully submits claims 16-26 and 43-46 are definite in view of the disclosure as filed. In light of the discussion above, Applicant traverses the statements in the Office Action, that the term “coradial” “is not used in the specification,” “not described in the original specification,” or “is vague.” Office Action, page 2, third paragraph and fourth paragraph; page 3, first full paragraph and fourth paragraph.

Reconsideration and allowance of claims 16-26 and 43-46 are respectfully requested.

103 Rejection of the Claims

In the Office Action, claims 16 – 20, 24, 26, 43, 45 and 46 were rejected under 35 USC § 103(a) as being unpatentable over Nelson et al. (U.S. Patent No. 6,249,708), hereinafter Nelson.

Claim 16-20, 24, 26, 45 and 46

Applicant respectfully traverses the rejections of claims 16-20, 24, 26, 45 and 46. The rejections fail, among other reasons, because the reference does not teach all the elements of claim 16. Applicant cannot find in the applied reference, for example, individually insulated coradial conductors including a first conductor and a second conductor, the first conductor comprised of a first material, and the second conductor comprised of a second material, wherein the first material has a different stiffness than the second material, as recited in claim 16 and incorporated in claims 17-20, 24, 26, 45 and 46.

Additionally, Examiner rejected claims 16-20, 24, 26, 45 and 46 based on Nelson alone. Applicant respectfully traverses the single reference rejections under 35 U.S.C. § 103 since not all of the recited or incorporated elements of claims 16-20, 24, 26, 45 and 46 are found in the single reference, as stated above. Applicant assumes that the Examiner is taking official notice of the missing elements. In fact, the statement in the Office Action at page 4, last paragraph, that “it was known in the art that leads are provided with insulated conductors being different materials, wherein the first material has a different stiffness than a second material to provide . . . different flexibility/stiffness to the lead,” is unsupported. Applicant respectfully objects to the

taking of official notice with single reference obviousness rejections and, pursuant to M.P.E.P. § 2144.03, Applicant respectfully traverses and requests that the Examiner cite references in support of this position. Alternatively, Applicant submits the assertions made are unsupported by the reference and therefore are within the personal knowledge of the Examiner. Applicant requests an affidavit supporting the unsupported assertions as required by 37 CFR 1.104(d)(2), or removal of the unsupported assertions.

Furthermore, Applicant traverses the rejections because the applied reference does not identify a proper motivation to modify Nelson. According to M.P.E.P. § 2143.01, the mere fact that references *can* be modified does not render the resultant combination obvious unless prior art also suggests (i.e. a prior art supported, objective suggestion) the desirability of the modification. Pursuant to M.P.E.P. § 706.02(j), “[t]he initial burden is on the Examiner to provide some suggestion of the desirability of doing what the inventor has done.” See also *In Re San Su Lee*, 277 F.3d 1338 (CAFC 2002). Applicant respectfully submits that the evidence of record does not appear to identify an objective source for the motivation to modify Nelson in the manner proposed. The Examiner has not stated how Nelson establishes that it would be in need of individually insulated coradial conductors including a first conductor and a second conductor, the first conductor comprised of a first material, and the second conductor comprised of a second material, wherein the first material has a different stiffness than the second material, as recited in claim 16 and incorporated in claims 17-20, 24, 26, 45 and 46. Applicant cannot find any suggestion in Nelson to employ such components. Applicant respectfully requests the Examiner identify an objective source for the motivation to modify the applied reference in the manner proposed. Alternatively, it appears, the requisite motivation for modifying Nelson with the knowledge of one of skill in the art is lacking, and therefore, proper *prima facie* obviousness has not been established.

Further still, the rejections of claims 16-20, 24, 26, 45 and 46 also fail because the rejections do not consider the claim as a whole. In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences *themselves* would have been obvious, but whether the claimed invention *as a whole* would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983); *Interconnect Planning*

Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985); MPEP § 2141.02. For example, the Examiner states, “It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the lead as taught by Nelson, with insulated coradial conductors being different materials, wherein the first material has a different stiffness than a second material since it was known in the art that leads are provided with insulated coradial conductors being different materials, wherein the first material has a different stiffness than a second material to provide . . . different flexibility/stiffness to the lead.” Office Action, page 4, last paragraph. Applicant respectfully submits the Examiner merely states the differences of the claim with respect to the prior art are obvious instead of focusing on the claim as a whole. Because the rejections focus upon the differences of the claim and not the claim as a whole, a proper *prima facie* case of obviousness has not been established. Additionally, by failing to consider the invention as a whole, the Office Action uses hindsight reconstruction. The teaching or suggestion to make the claimed device must be found in the prior art, not in applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP § 2143. The Examiner must avoid hindsight. *In re Bond*, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990).

Reconsideration and allowance of claims 16-20, 24, 26, 45 and 46 are respectfully requested.

Claim 43

Applicant respectfully traverses the rejection of claim 43. The rejection fails, among other reasons, because the reference does not teach all the elements of claim 43. Applicant cannot find in the applied reference, for example, the coradial conductors form a single lumen within the lead body, as recited in claim 43.

To the extent that the Examiner is taking Official Notice of the missing elements with this single reference obviousness rejection, Applicant respectfully traverses pursuant to M.P.E.P. § 2144.03 and requests that the Examiner cite references showing this absent element or provide an affidavit supporting the unsupported assertions as required by 37 CFR 1.104(d)(2).

Furthermore, Applicant traverses the rejection because the applied reference does not identify a proper motivation to modify Nelson. Pursuant to M.P.E.P. § 706.02(j), “[t]he initial

burden is on the Examiner to provide some suggestion of the desirability of doing what the inventor has done.” See also *In Re San Su Lee*, 277 F.3d 1338 (CAFC 2002). Applicant respectfully submits that the evidence of record does not appear to identify an objective source for the motivation to modify Nelson in the manner proposed. The Examiner has not stated how Nelson establishes that it would be in need of conductors that form a single lumen within the lead body. Therefore, proper *prima facie* obviousness has not been established.

Additionally, Applicant respectfully submits that claim 43 is patentable at least as a dependent claim of patentable base claim 16, and the discussion for claim 16 above is repeated in support of claim 43.

Reconsideration and allowance of claim 43 are respectfully requested.

In the Office Action, claims 21 – 23, 25 and 44 were rejected under 35 USC § 103(a) as being unpatentable over Nelson et al. (U.S. Patent No. 6,249,708).

Claims 21-23, 25 and 44

Applicant respectfully traverses the rejections of claims 21-23, 25 and 44. The rejections fail, among other reasons, because the applied reference does not teach all the elements of the claims. Applicant cannot find in the applied reference, for example, the first material comprises MP35N, as recited in claim 21. Additionally, Applicant cannot find in the applied reference, the second material comprises Pt/Ta, as recited in claim 22. Further, Applicant cannot find in the applied reference, the first coradial conductor is disposed only in the second and third sections, as recited in claim 23. Further still, Applicant cannot find in the applied reference, for example, at least one of the individually insulated coradial conductors is formed of material having heat setting capabilities, as recited in claim 25. Moreover, Applicant cannot find in the applied reference, for example, where the first conductor is disposed only in the first and third sections, as recited in claim 44.

Applicant respectfully traverses the single reference rejections under 35 U.S.C. § 103 since not all of the recited elements of the claims are found in the single reference, as stated above. Additionally, the Office Action states, “Nelson . . . does not disclose expressly the first material being MP35N and the second material being Pt/Ta . . . , one of the conductors having a

head setting capability . . . , and the first conductor disposed only in the second and third sections.” Office action, page 5, second paragraph. To the extent that the Examiner is taking Official Notice with single reference obviousness rejections, Applicant respectfully traverses pursuant to M.P.E.P. § 2144.03 and requests that the Examiner cite references showing these absent elements or provide an affidavit supporting the unsupported assertions as required by 37 CFR 1.104(d)(2).

Furthermore, Applicant traverses the rejections because the applied reference does not appear to identify an objective source for the motivation to modify Nelson in the manner proposed. See M.P.E.P. § 2143.01. Applicant is unaware of a requirement for showing an advantage, use for a particular purpose, or solution of a stated problem. Office Action, page 5, second paragraph. Rather, pursuant to M.P.E.P. § 706.02(j), “[t]he initial burden is on the Examiner to provide some suggestion of the desirability of doing what the inventor has done.” See also *In Re San Su Lee*, 277 F.3d 1338 (CAFC 2002). The Examiner has not stated how Nelson establishes that it would be in need of individually insulated coradial conductors including a first conductor and a second conductor, the first conductor comprised of a first material, and the second conductor comprised of a second material, wherein the first material has a different stiffness than the second material, as recited in claim 16 and incorporated in claims 21-23, 25 and 44. Therefore, proper *prima facie* obviousness has not been established.

Additionally, Applicant respectfully submits that claims 21-23, 25 and 44 are patentable at least as dependent claims of patentable base claim 16, and the discussion for claim 16 above is repeated in support of claims 21-23, 25 and 44.

Reconsideration and allowance of claims 21-23, 25 and 44 are respectfully requested.

In the Office Action, claims 16 – 20, 24 and 43 - 46 were rejected under 35 USC § 103(a) as being unpatentable over Cross, Jr. et al. (U.S. Patent No. 5,935,159), hereinafter Cross.

Claim 16

Applicant respectfully traverses the rejection of claim 16. The rejection fails, among other reasons, because the reference does not teach all the elements of claim 16. Applicant cannot find in the applied reference, for example, individually insulated coradial conductors

including a first conductor and a second conductor, the first conductor comprised of a first material, and the second conductor comprised of a second material, wherein the first material has a different stiffness than the second material, as recited in claim 16.

Applicant notes the Office Action lists assertions unsupported by the reference such as, “it was known in the art that leads are provided with insulated conductors being different materials, wherein the first material has a different stiffness than a second material to provide . . . different flexibility/stiffness to the lead.” Office Action, page 6, second full paragraph. To the extent that the Examiner is taking Official Notice by this single reference obviousness rejection, Applicant respectfully traverses pursuant to M.P.E.P. § 2144.03 and requests that the Examiner cite references showing this absent element or provide an affidavit supporting the unsupported assertions as required by 37 CFR 1.104(d)(2).

Furthermore, Applicant traverses the rejection because the applied reference does not appear to identify an objective source for the motivation to modify Cross in the manner proposed. See M.P.E.P. § 2143.01. The Examiner has not stated how Cross establishes that it would be in need of individually insulated coradial conductors including a first conductor and a second conductor, the first conductor comprised of a first material, and the second conductor comprised of a second material, wherein the first material has a different stiffness than the second material. Therefore, proper *prima facie* obviousness has not been established.

Further still, the Office Action states, “It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the lead as taught by Cross, with insulated coradial conductors being different materials, wherein the first material has a different stiffness than a second material since it was known in the art that leads are provided with insulated coradial conductors being different materials, wherein the first material has a different stiffness than a second material to provide . . . different flexibility/stiffness to the lead.” Office Action, page 6, second full paragraph. Applicant respectfully submits this improperly states the differences of the claim with respect to the prior art are obvious instead of focusing on the claim as a whole, as discussed above.

Additionally, Applicant respectfully requests clarification regarding the final sentence of the second full paragraph on page 6 of the Office Action. The sentence appears incomplete.

Reconsideration and allowance of claim 16 are respectfully requested. Additionally, clarification of the Office Action, as described above, is respectfully requested.

Claims 17-20 and 24

Applicant respectfully submits that claims 17-20 and 24 are patentable at least as dependent claims of patentable base claim 16, and the discussion for claim 16 above is repeated in support of claims 17-20 and 24.

Reconsideration and allowance of claims 17-20 and 24 are respectfully requested.

Claim 43 and 44

Applicant respectfully traverses the rejections of claims 43 and 44. The rejections fail, among other reasons, because the reference does not teach all the elements of the claims. Applicant cannot find in the applied reference, for example, the coradial conductors form a single lumen within the lead body, as recited in claim 43. Additionally, Applicant cannot find in the applied reference, where the first conductor is disposed only in the first and third sections, as recited in claim 44.

To the extent that the Examiner is taking Official Notice by these single reference obviousness rejections, Applicant respectfully traverses pursuant to M.P.E.P. § 2144.03 and requests that the Examiner cite references showing these absent elements or provide an affidavit supporting the unsupported assertions as required by 37 CFR 1.104(d)(2).

Furthermore, Applicant traverses the rejections because the applied reference does not appear to identify an objective source for the motivation to modify Cross in the manner proposed. See M.P.E.P. § 2143.01. The Examiner has not stated how Cross establishes that it would be in need of conductors that form a single lumen within the lead body. Further, the Examiner has not stated how Cross establishes that it would be in need of the first conductor disposed only in the first and third sections. Therefore, proper *prima facie* obviousness has not been established.

Additionally, Applicant respectfully submits that claims 43 and 44 are patentable at least as dependent claims of patentable base claim 16, and the discussion for claim 16 above is repeated in support of claims 43 and 44.

Reconsideration and allowance of claim 43 and 44 are respectfully requested.

Claims 45 and 46

Applicant respectfully submits that claims 45 and 46 are patentable at least as dependent claims of patentable base claim 16, and the discussion for claim 16 above is repeated in support of claims 45 and 46.

Reconsideration and allowance of claims 45 and 46 are respectfully requested.

In the Office Action, claims 21 – 23, 25 and 26 were rejected under 35 USC § 103(a) as being unpatentable over Cross, Jr. et al. (U.S. Patent No. 5,935,159).

Claims 21-23 and 25

Applicant respectfully traverses the rejections of claims 21-23 and 25. The rejections fail, among other reasons, because the reference does not teach all the elements of the claims. Applicant is unable to find in the applied reference, for example, the first material comprises MP35N, as recited in claim 21. Additionally, Applicant cannot find in the applied reference, the second material comprises Pt/Ta, as recited in claim 22. Further, Applicant cannot find in the applied reference, the first coradial conductor is disposed only in the second and third sections, as recited in claim 23. Further still, Applicant cannot find in the applied reference, at least one of the individually insulated coradial conductors is formed of material having heat setting capabilities, as recited in claim 25.

Additionally, Examiner rejected claims 21-23 and 25 based on Cross alone. Moreover, the Office Action states, “Cross . . . does not disclose expressly the first material being MP35N and the second material being Pt/Ta . . . , one of the conductors having a heat setting capability.” Office Action, page 6, last paragraph to page 7, first paragraph. To the extent that the Examiner is taking Official Notice by these single reference obviousness rejections, Applicant respectfully traverses pursuant to M.P.E.P. § 2144.03 and requests that the Examiner cite references showing these absent elements or provide an affidavit supporting the unsupported assertions as required by 37 CFR 1.104(d)(2).

Furthermore, Applicant traverses the rejections because the applied reference does not appear to identify an objective source for the motivation to modify Cross in the manner proposed. Applicant is unaware of a requirement for showing an advantage, use for a particular purpose, or solution of a stated problem. Office Action, page 7, first paragraph. Rather, pursuant to M.P.E.P. § 706.02(j), “[t]he initial burden is on the Examiner to provide some suggestion of the desirability of doing what the inventor has done.” See also *In Re San Su Lee*, 277 F.3d 1338 (CAFC 2002). The Examiner has not stated how Cross establishes that it would be in need of individually insulated coradial conductors including a first conductor and a second conductor, the first conductor comprised of a first material, and the second conductor comprised of a second material, wherein the first material has a different stiffness than the second material, as recited in claim 16 and incorporated in claims 21-23 and 25. Therefore, proper *prima facie* obviousness has not been established.

Additionally, Applicant respectfully submits that claims 21-23 and 25 are patentable at least as dependent claims of patentable base claim 16, and the discussion for claim 16 above is repeated in support of claims 21-23 and 25.

Reconsideration and allowance of claims 21-23 and 25 are respectfully requested.

Claim 26

Applicant respectfully traverses the rejection of claim 26. The Office Action states, “It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the lead as taught by Cross, . . . with a two or three dimensional bias to allow the lead to be easily located in a particular part of the body and allow the lead to remain in that location.” Office Action, page 7, last paragraph. Applicant respectfully submits this improperly states the differences of the claim with respect to the prior art are obvious instead of focusing on the claim as a whole.

Additionally, Applicant respectfully submits that claim 26 is patentable at least as a dependent claim of patentable base claim 16, and the discussion for claim 16 above is repeated in support of claim 26.

Reconsideration and allowance of claim 26 are respectfully requested.

Documents Cited But Not Relied Upon in this Office Action

Applicant has reviewed the references made of record and not relied upon, but does not find them to be any more relevant than the patents discussed in the Office Action. Because these references are not made part of the rejections of this Office Action, Applicant need not address the additional references. Applicant reserves the right to further address any rejections therefrom.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney ((612) 359-3276) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743

Respectfully submitted,

BRUCE TOCKMAN ET AL.

By their Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.

P.O. Box 2938

Minneapolis, MN 55402

(612) 359-3276

Date Dec. 18, 2003

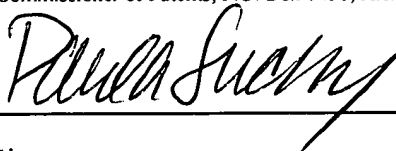
By 

Catherine I. Klima-Silberg
Reg. No. 40,052

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 18 day of December, 2003.



Name



Signature